



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,296	09/12/2003	Jagadish C. Sircar	AVANIR.112A	7448

20995 7590 11/20/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

RAHMANI, NILOOFAR

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,296

Applicant(s)

SIRCAR ET AL.

Examiner

Niloofer Rahmani

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-49 is/are pending in the application.
- 4a) Of the above claim(s) 18-48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8, 11, 13, 15 and 49 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9, 10, 12, 14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4, 6-49 are pending. Claim 5 is cancelled.

Applicant's election without traverse of Group I in the reply filed on 10/13/2006 is acknowledged.

Claims 1-4, 6-17, and 49 are examined. Claims 18-48 remaining subject matter being drawn to the non-elected invention are withdrawn per 37 CFR 1.142(b).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. **Priority**

This application is filed on 09/12/2003, which claims benefit of 60/410,761, filed on 09/12/2002.

3. **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 9-10, 12, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 9 are rejected because the terms "S-1 to S-25" and "S-4, S-5, S-6, S-7, S-8, S-11, S-13, S-15 and S-16" are confusing. The claims need to be complete as written because they are referring as S-1 to S-25. These terms need to identify in specification and then inserted to the claims. Correction is required.

4. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Farina et al., IL Farmaco, 2001, Vol. 56, pages 113-116. Farina et al. disclosed the instant claimed compound on page 115, Table 6, compound 6b, wherein X being N, R being Et, and R₁ being H. Therefore, the instant claim is anticipated by Farina et al.

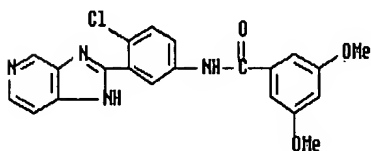
5. Claims 1-4, 7, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Viscardi et al., Journal of Heterocyclic Chemistry, 1990, Vol. 27, pages 1825-9. Viscardi et al. disclosed the instant claimed compound on page

Art Unit: 1625

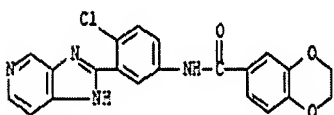
1826, Table 1, compounds 8 and 9. Therefore, the instant claim is anticipated by Viscardi et al.

6. Claims 1-4, 6-7, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rubin et al., US 2005/0085519. Rubin et al. disclosed the instant claimed compounds

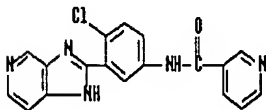
CN Benzamide, N-[4-chloro-3-(1H-imidazo[4,5-c]pyridin-2-yl)phenyl]-3,5-dimethoxy-



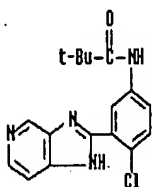
CN 1,4-Benzodioxin-6-carboxamide, N-[4-chloro-3-(1H-imidazo[4,5-c]pyridin-2-yl)phenyl]-2,3-dihydro



CN 3-Pyridinecarboxamide, N-[4-chloro-3-(1H-imidazo[4,5-c]pyridin-2-yl)phenyl]



CN Propanamide, N-[4-chloro-3-(1H-imidazo[4,5-c]pyridin-2-yl)phenyl]-2,2-Dimethyl



. Therefore, the instant

claim is anticipated by Rubin et al.

7. Allowable Subject Matter

Claims 8,11,13,15, and 49 are patentable over Viscardi et al., Journal of Heterocyclic Chemistry, 1990, Vol. 27, pages 1825-9. The reference teaches non-substituted pyridine ring compounds instead of the amide substituted in the pyridine ring compounds of the instant application. Therefore, the claims are free of prior art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Mckenzie, can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/661,296

Page 6

Art Unit: 1625

NILOOFAR RAHMANI

11/09 /2006

OK


D. MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625